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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,842	06/13/2002	Giovanni Battista Zenga	DYOUP0227US	2178

7590 12/31/2003  
Cynthia S Murphy  
Renner Otto Boisselle & Sklar  
19th Floor  
1621 Euclid Avenue  
Cleveland, OH 44115

EXAMINER

ZIMMERMAN, JOHN J

ART UNIT PAPER NUMBER

1775

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



## SECOND OFFICE ACTION

### *Amendment*

1. The letter titled Response to Office Action Dated June 5, 2003 received October 10, 2003 has been entered. Claims 1-10 and 12-19 are pending in this application.

### *Claim Rejections - 35 USC § 112, Second Paragraph*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4-10 and 12-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1, 4-10 and 12-18, it is unclear as to what dimensions qualify a hole as a "microhole" (e.g. see independent claim 1, lines 2 and 3). The applicant's disclosure gives no guidance in determining the scope of the term "microhole". It is not clear how small a hole must be in order to meet this limitation. For all that can be determined, the term "microhole" may have limits of tens, hundreds or thousands or more of microns. For purposes of claim interpretation in applying prior art in the ensuing rejections under 35 U.S.C. 102 and 103, the term "microhole" will simply be interpreted as having small holes.

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5. Regarding claims 5-10, it is indefinite as to how a tubular filter element is to be combined with a medical device or a heat sink.

***Claim Rejections - 35 USC § 112, First Paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 5-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Regarding claims 5-10, it is not clear where the originally filed disclosure describes a tubular filter element combined with a medical device or a heat sink. Unless proper support in the original disclosure is shown, the combination of these limitations is considered new matter.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 4-5, 9-10 and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Klemm (U.S. Patent 4,039,397).

10. Klemm discloses electroforming cylindrical screens (e.g. see Figures 1-4; column 4, lines 5-29). Regarding the intended use of the devices recited in claim 5 and claims 9-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The mere fact that the sieve is metal means that will function as a heat sink to whatever it may be affixed to.

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*Allowable Subject Matter*

11. Claims 2, 3 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

12. Applicant's arguments filed October 10, 2003 have been fully considered but they are not persuasive.

13. Regarding the rejection of claims 1, 4-10 and 12-18 under 35 U.S.C. 112, second paragraph, as being indefinite because it is unclear as to what dimensions qualify a hole as a "microhole" (e.g. see independent claim 1, lines 2 and 3), applicant argues that such an expression is a well-understood term of art, whereby no numerical range limitation is necessary. Applicant also cites Lennox Lasers Tungsten Aperture technical data as "Exhibit A" as evidence and also argues that applicant's specification recites hole sizes. Regarding the issue of "Exhibit A", the examiner notes that this exhibit appears to have no relationship to the applicant's specification and there is no evidence of record that the applicant's specification was intended, as originally filed, to rely on Exhibit A to define the term "microhole" relative to applicant's invention. Regarding the issue that applicant's specification gives examples of microholes, the examiner again notes that the applicant's disclosure gives no actual guidance in determining the actual scope of the term "microhole" as it is to be interpreted in the claims. While some specific diameters of holes may be given in the specification, there is no overall definition of what

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diameters fall (or do not fall) within the scope of "microholes" for the purposes of the applicant's invention.

14. It should also be noted that applicant's amendments to independent claim 1 created a tubular filter element combined with a medical device or a heat sink in claims 5-10. It is not clear how these claims are to be interpreted since no such devices were described in the original disclosure.

15. Regarding the remaining art based rejection of the claims under 35 U.S.C. 102(b) as being anticipated by Klemm (U.S. Patent 4,039,397), Klemm discloses electroforming cylindrical screens (e.g. see Figures 1-4; column 4, lines 5-29). Applicant argues that none of the cited art documents disclose the features of the claims, but Klemm clearly shows a screen having physical characteristics that meet the physical limitations of the claims. Although Klemm may not recite that his screen is intended as a filter element, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

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limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

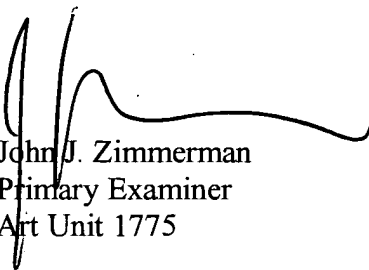
16. Applicant's amendments adding limitations to the independent claim and adding new claims necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (703) 308-2512. The examiner can normally be reached on 8:30am-5:00pm, M-F. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
December 23, 2003